

## Transmittal Memorandum

**VIA EXPRESS MAIL NO. EI 134757185 US**

**TO :** Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

#85353414

**FROM :** Keri Ann K.S. Krzykowski, Esq.

**DATE :** June 17, 2013

**RE :** Registration No.: 4,215,075  
Date of Issue: September 25, 2012  
Mark: "ALOHA"  
Petitioner: Koaloha, Inc.  
Respondent: Ricard Borden

We are sending you the following:

ORIG.	COPIES	DATED	DESCRIPTION
1		6/17/2013	Petition For Cancellation
1		6/17/2013	Filing Fee (\$300.00)
1		6/17/2013	Postcard receipt of Petition For Cancellation and Filing Fee

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- ☒ **For necessary action**
- ☐ Are returned herewith

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as noted below & return
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REMARKS:

ImanageDB:2436837.1

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**IN THE UNITED STATES PATENT & TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Registration No. 4,215,075

Mark: "ALOHA"

Date of Issue: September 25, 2012

KOALOHA, INC., a Hawaii  
corporation,

Petitioner,

v.

RICARD BORDEN,  
an individual,

Respondent.

Cancellation No. \_\_\_\_\_

Registration No. 4,215,075

06/21/2013 SWILSON1-00000001 4215075

01 FC:6401

300.00 OP

**PETITION FOR CANCELLATION**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner of Trademarks, P.O. Box 1451, Alexandria, VA 22304-1451, on the date shown below.

Keri Ann K.S. Kozlowski  
Date: 6/18/13 60,603

KOALOHA, INC., a Hawaii corporation doing business as Koaloha Ukulele and having a principal place of business and mailing address at 744 Kohou Street, Honolulu, Hawaii 96817 ("**Petitioner**"), believes it has been and will be damaged by U.S. Trademark Registration No. 4,215,075 for "ALOHA" for "String instruments, namely ukuleles," in International Class 15 (the "**Aloha Registration**"), which was issued on September 25, 2012, to RICARD BORDEN, identified as having a mailing address at 2720 Borthwich Avenue, Henderson, Nevada 89044 ("**Respondent**"), and hereby petitions to cancel the same.

As grounds therefor, Petitioner alleges as follows:

1. Petitioner has acquired valuable common law trademark rights in the mark "KOALOHA" ("**Petitioner's Mark**") in connection with ukuleles.



\*06-18-2013\*

2. Petitioner has extensively and continuously used in commerce the mark “KOALOHA” in connection with ukuleles since at least as early as August 30, 1995.

3. The goods in connection with which Petitioner has used Petitioner’s mark “KOALOHA,” are collectively referred to herein as the “**Petitioner’s Goods.**”

4. For many years, Petitioner has continuously advertised, sold and distributed ukuleles in connection with the mark “KOALOHA,” throughout the United States. Petitioner has developed an exceedingly valuable goodwill with respect to its marks.

5. By virtue of its efforts, the expenditure of considerable sums for advertising and promotional activities, and by virtue of the excellence of Petitioner’s ukuleles, Petitioner has gained for its mark “KOALOHA,” a most valuable reputation.

6. On information and belief, on or about June 22, 2011, Respondent filed an intent-to-use U.S. Trademark Application Serial No. 85/353,414 for “ALOHA” for “String instruments, namely ukuleles,” in International Class 15.

7. Respondent’s trademark application matured into U.S Registration No. 4,215,075 (the “**Aloha Registration**”).

8. The Aloha Registration asserts December 1, 2011, as the date of first use of the “ALOHA” mark.

9. The Aloha Registration was issued in connection with “String instruments, namely ukuleles,” in International Class 15 (“**Respondent’s Goods**”).

10. On or about May 4, 2012, Petitioner filed intent-to-use U.S. Trademark Application Serial No. 85/617,638 for “KOALOHA” for “ukuleles and parts and accessories therefor, namely ukuleles strings and ukulele cases” in International Class 15 (the “**Koaloaha Application**”).

11. On or about March 24, 2013, the Koaloha Application was refused registration on the basis of an asserted likelihood of confusion with the Aloha Registration.

12. There is no issue as to priority of use. Petitioner has been using its marks “KOALOHA” mark since well before Respondent’s asserted December 1, 2011, date of first use of its “ALOHA” mark in connection with Respondent’s Goods, and before the filing of Respondent’s application for registration of “ALOHA” on June 22, 2011.

13. Respondent’s Goods are identical and/or related to Petitioner’s Goods.

14. Respondent’s “String instruments, namely ukuleles” are identical and/or related to Petitioner’s ukuleles.

15. Respondent’s “String instruments, namely ukuleles,” in International Class 15 are identical and/or related to Petitioner’s “ukuleles and parts and accessories therefor, namely ukuleles strings and ukulele cases” in International Class 15.

16. Ukuleles and strings are often marketed and sold under the same mark, as shown by the following:

(a) U.S. Trademark Registration No. 4,244,680 for “ARIA” for “Fretted stringed musical instruments-namely, flat top guitars including classic guitars, western guitars, folk guitars and 12-string guitars, electric and non-electric arched top guitars, solid body and acoustic body electric guitars, tenor, standard and baritone *ukuleles*, round back and flat back mandolins, lutes and 4-string, 5-string and 6-string banjos; guitar, mandolin and banjo parts and fittings, namely, guitar, mandolin and banjo patent heads; guitar, mandolin and *ukulele strings*; foot stools specially adapted for use with guitars; guitar capos; guitar stands; guitar straps; guitar picks; guitar pitch-pipes; cases specially adapted for use with guitars, mandolins and banjos; carrying bags specially adapted for use with guitars; guitar parts and fittings, namely, guitar

string winders; guitar parts, namely, guitar pickups; guitar bridges; guitar parts, namely, guitar tailpieces, guitar bridge pins and guitar endpins; and violin, viola, cello and bass bows,” in International Class 15, a true and correct copy of which is attached hereto as Exhibit “A” (emphasis added); and

(b) U.S. trademark registration no. 3034306 for “THE HOPKINS” for “Musical instruments, namely, accordions, zithers, banjos, bass violins, cellos, acoustic guitars, electric guitars, acoustic/electric guitars, acoustic basses, electric basses, acoustic/electric basses, lyres, mandolins, *ukuleles*, violas, and violins; and musical instrument accessories, namely, instrument cases, instrument bags, *strings* and instrument bows,” International Class 15, attached hereto as Exhibit “B” (emphasis added).

17. Ukuleles and cases are also often marketed and sold under the same mark, as shown by the following:

(a) U.S. trademark registration no. 4312525 for “D’LUCA” for “Accordions; Acoustic guitars; Banjos; Bass guitars; Bows for musical instruments; Brass instruments; Cellos; Clarinets; Drums; Electric and electronic musical instruments; Electric bass guitars; Electric guitars; Euphoniums; Flutes; French horns; Guitars; Horns; Keyboard instruments; Mandolins; Musical instrument accessories, namely, stands, *cases*, carrying bags and storage bags; Musical instruments; Musical instruments, namely, bass guitars; Musical instruments, namely, string basses; Piccolos; Saxophones; String instruments; Tambourines; Trombones; Trumpets; *Ukuleles*; Violas; Violins; Wind instruments; Woodwind instruments; Xylophones,” International Class 15, attached hereto as Exhibit “C” (emphasis added); and

(b) U.S. trademark registration no. 4147374 for “EDDY FIN” for “Musical instruments, namely, *ukuleles* and related accessories, namely, stands, straps, picks, *cases* and tuners *for ukuleles*,” in International Class 15, attached hereto as Exhibit “D” (emphasis added).

18. Petitioner’s Mark “KOALOHA” contains Respondent’s Mark “ALOHA” in its entirety.

19. The only difference between “ALOHA” and “KOALOHA” is the addition of the letters “K” and “O”.

20. Respondent’s Mark “ALOHA” and Petitioner’s mark “KOALOHA” were determined to be confusingly similar during the examination of the Koaloha Application.

21. If Respondent is permitted to retain the Aloha Registration, and thereby the *prima facie* exclusive right to use in commerce Respondent’s Mark in connection with goods and services identical and/or related to Petitioner’s Goods, confusion in trade is likely to result, to the detriment of Petitioner, who has expended considerable sums and effort in promoting its mark “KOALOHA.” Any objection, or fault found with the Respondent’s Goods marketed under Respondent’s Mark would reflect on, and injure, the reputation Petitioner has established for its goods sold in connection with its mark.

22. The continued use and registration of Respondent’s Mark would result in confusion, mistake, and/or deception as to the source or origin of the Respondent’s Goods, leading consumers to believe that they are somehow affiliated with, approved, sponsored, or licensed by Petitioner, or otherwise emanate from Petitioner, resulting in the loss of sales to Petitioner. 15 U.S.C. § 1052(d).

23. The continued use and registration of Respondent’s Mark, concurrently with Petitioner’s Mark, will become a source of irreparable damage and injury to Petitioner’s

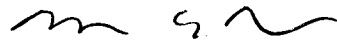
reputation and goodwill through the generation of confusion, mistake, and/or deception, the dilution of Petitioner's mark, and the diminution of Petitioner's ability to control the quality of the goods and services provided thereunder because consumers are likely to attribute the source of Respondent's Goods to Petitioner.

24. If Respondent is permitted to rely on and/or retain the Aloha Registration, a cloud will be placed on Petitioner's title in and to its mark "KOALOHA," and on its right to enjoy the free and exclusive use thereof in connection with the sale of his goods and services, all to the damage and harm of Petitioner.

The fee required by 37 C.F.R. § 2.6(a)(16) is enclosed herewith.

WHEREFORE, Petitioner respectfully requests the cancellation of U.S. Registration No. 4,215,075 for "ALOHA" issued on September 25, 2012, pursuant to 15 U.S.C. § 1064.

DATED: Honolulu, Hawaii this 18 day of June, 2013.



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Attorney for Petitioner  
KOALOHA, INC.

**IN THE UNITED STATES PATENT & TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Registration No. 4,215,075  
Mark: "ALOHA"  
Date of Issue: September 25, 2012

KOALOHA, INC., a Hawaii	)	
corporation,	)	
	)	
Petitioner,	)	
	)	Cancellation No. _____
v.	)	
	)	Registration No. 4,215,075
RICARD BORDEN,	)	
an individual,	)	
	)	
Respondent.	)	
_____	)	

**PROOF OF SERVICE**

I HEREBY CERTIFY that a true and correct copy of the attached PETITION  
FOR CANCELLATION was mailed by U.S. Certified Mail on the date noted below, to the  
following:

Wayne V. Harper, Esq.  
Harper IP Law, PA  
710 S. Howard Avenue  
Suite 106-405  
Tampa, FL 33606

also via e-mail: [wayne@harperiplaw.com](mailto:wayne@harperiplaw.com)

Harper IP Law, PA  
711 S. Howard Ave.  
Tampa, FL 33606

Attorney for Respondent  
RICARD BORDEN



DATED: Honolulu, Hawaii this 18 day of June, 2013.



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Honolulu, HI 96813  
(808) 544-3835  
Attorneys for Petitioner  
KOALOHA, INC.

ImanageDB:2427028.1

# United States of America

United States Patent and Trademark Office

# ARIA

**Reg. No. 4,244,680**

**Registered Nov. 20, 2012**

**Int. Cls.: 9 and 15**

**TRADEMARK**

**PRINCIPAL REGISTER**

ARAI AND CO., INC. (JAPAN CORPORATION)  
NO. 12-2 KANDACHO, CHIKUSAKU  
NAGOYA, JAPAN 464-0077

FOR: GUITAR CABLES AND GUITAR AMPLIFIERS, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 4-10-1960; IN COMMERCE 4-10-1960.

FOR: FRETTED STRINGED MUSICAL INSTRUMENTS---NAMELY, FLAT TOP GUITARS INCLUDING CLASSIC GUITARS, WESTERN GUITARS, FOLK GUITARS AND 12-STRING GUITARS, ELECTRIC AND NON-ELECTRIC ARCHED TOP GUITARS, SOLID BODY AND ACOUSTIC BODY ELECTRIC GUITARS, TENOR, STANDARD AND BARITONE UKULELES, ROUND BACK AND FLAT BACK MANDOLINS, LUTES AND 4-STRING, 5-STRING AND 6-STRING BANJOS; GUITAR, MANDOLIN AND BANJO PARTS AND FITTINGS, NAMELY, GUITAR, MANDOLIN AND BANJO PATENT HEADS; GUITAR, MANDOLIN AND UKULELE STRINGS; FOOT STOOLS SPECIALLY ADAPTED FOR USE WITH GUITARS; GUITAR CAPOS; GUITAR STANDS; GUITAR STRAPS; GUITAR PICKS; GUITAR PITCH-PIPES; CASES SPECIALLY ADAPTED FOR USE WITH GUITARS, MANDOLINS AND BANJOS; CARRYING BAGS SPECIALLY ADAPTED FOR USE WITH GUITARS; GUITAR PARTS AND FITTINGS, NAMELY, GUITAR STRING WINDERS; GUITAR PARTS, NAMELY, GUITAR PICKUPS; GUITAR BRIDGES; GUITAR PARTS, NAMELY, GUITAR TAILPIECES, GUITAR BRIDGE PINS AND GUITAR ENDPINS; AND VIOLIN, VIOLA, CELLO AND BASS BOWS, IN CLASS 15 (U.S. CLS. 2, 21 AND 36).

FIRST USE 4-10-1960; IN COMMERCE 4-10-1960.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 885,891, 1,677,560 AND OTHERS.

SER. NO. 85-491,280, FILED 12-9-2011.

SUSAN RICHARDS, EXAMINING ATTORNEY



*David J. Kappas*

Director of the United States Patent and Trademark Office

**EXHIBIT A**

**Int. Cl.: 15**

**Prior U.S. Cls.: 2, 21 and 36**

**United States Patent and Trademark Office**

**Reg. No. 3,034,306**

**Registered Dec. 27, 2005**

**TRADEMARK  
PRINCIPAL REGISTER**

**THE HOPKINS**

HOPKINS, PAUL, A. (UNITED STATES INDIVIDUAL)

3563 HWY. 231 N.

SHELBYVILLE, TN 37160

FOR: MUSICAL INSTRUMENTS, NAMELY, ACCORDIONS, ZITHERS, BANJOS, BASS VIOLINS, CELLOS, ACOUSTIC GUITARS, ELECTRIC GUITARS, ACOUSTIC/ELECTRIC GUITARS, ACOUSTIC BASSES, ELECTRIC BASSES, ACOUSTIC/ELECTRIC BASSES, LYRES, MANDOLINS, UKULELES, VIOLAS, AND VIOLINS; AND MUSICAL INSTRUMENT ACCESSORIES, NAMELY, INSTRUMENT CASES, INSTRUMENT BAGS, STRINGS

AND INSTRUMENT BOWS, IN CLASS 15 (U.S. CLS. 2, 21 AND 36).

FIRST USE 12-11-1996; IN COMMERCE 12-11-1996.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SEC. 2(F).

SER. NO. 78-354,370, FILED 1-20-2004.

ELLEN PERKINS, EXAMINING ATTORNEY

**United States of America**  
United States Patent and Trademark Office

**D'LUCA**

**Reg. No. 4,312,525**

**Registered Apr. 2, 2013**

**Int. Cl.: 15**

**TRADEMARK**

**PRINCIPAL REGISTER**

SKY BLUE TELEMARKETING, INC. (CALIFORNIA CORPORATION)  
780 S. MILLIKEN AVE. STE C  
ONTARIO, CA 91761

FOR: ACCORDIONS; ACOUSTIC GUITARS; BANJOS; BASS GUITARS; BOWS FOR MUSICAL INSTRUMENTS; BRASS INSTRUMENTS; CELLOS; CLARINETS; DRUMS; ELECTRIC AND ELECTRONIC MUSICAL INSTRUMENTS; ELECTRIC BASS GUITARS; ELECTRIC GUITARS; EUPHONIUMS; FLUTES; FRENCH HORNS; GUITARS; HORNS; KEYBOARD INSTRUMENTS; MANDOLINS; MUSICAL INSTRUMENT ACCESSORIES, NAMELY, STANDS, CASES, CARRYING BAGS AND STORAGE BAGS; MUSICAL INSTRUMENTS; MUSICAL INSTRUMENTS, NAMELY, BASS GUITARS; MUSICAL INSTRUMENTS, NAMELY, STRING BASSES; PICCOLOS; SAXOPHONES; STRING INSTRUMENTS; TAMBOURINES; TROMBONES; TRUMPETS; UKULELES; VIOLAS; VIOLINS; WIND INSTRUMENTS; WOODWIND INSTRUMENTS; XYLOPHONES, IN CLASS 15 (U.S. CLS. 2, 21 AND 36).

FIRST USE 7-5-2007; IN COMMERCE 7-5-2007.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

THE WORDING D'LUCA HAS NO MEANING IN A FOREIGN LANGUAGE.

SER. NO. 85-693,131, FILED 8-1-2012.

MARTHA FROMM, EXAMINING ATTORNEY



*Lisa Staret Ken*  
Acting Director of the United States Patent and Trademark Office

**EXHIBIT C**

**United States of America**  
United States Patent and Trademark Office

**EDDY FINN**

**Reg. No. 4,147,374**

**Registered May 22, 2012**

**Int. Cl.: 15**

**TRADEMARK**

**PRINCIPAL REGISTER**

SHS INTERNATIONAL, INC. (INDIANA CORPORATION)  
1922 WEST BANTA ROAD  
INDIANAPOLIS, IN 46217

FOR: MUSICAL INSTRUMENTS, NAMELY, UKULELES AND RELATED ACCESSORIES,  
NAMELY, STANDS, STRAPS, PICKS, CASES AND TUNERS FOR UKULELES, IN CLASS  
15 (U.S. CLS. 2, 21 AND 36).

FIRST USE 1-0-2011; IN COMMERCE 1-0-2011.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PAR-  
TICULAR FONT, STYLE, SIZE, OR COLOR.

THE NAME "EDDY FINN" DOES NOT IDENTIFY A PARTICULAR LIVING INDIVIDUAL.

SN 85-160,142, FILED 10-25-2010.

DORITT L. CARROLL, EXAMINING ATTORNEY



*David J. Kappas*

Director of the United States Patent and Trademark Office

**EXHIBIT D**